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Docket No.: 03485/100H799-US1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: SUBRAMANIAN et al.

Serial No.:	10/001,772	Art Unit:	2166
Confirmation No.:	4306	Examiner:	Stephen GRAVINI
Filed:	October 31, 2001		
For:	INTERNET CONTEXTUAL COMMUNICATION SYSTEM		

SECOND RENEWED PETITION TO MAKE SPECIAL PURSUANT TO MPEP § 708.02 VII ACCELERATED EXAMINATION

Hon. Commissioner of
Patents and Trademarks
Washington, DC 20231

Sir:

This a Second Renewed Petition to Make Special pursuant to 37 C.F.R. § 1.102(d) to advance the above-identified patent application out of turn for examination. On December 17,

2003, the United States Patent and Trademark Office ("U.S.P.T.O") denied the Renewed Petition to Make Special filed on November 3, 2003 for failure to adequately meet the requirements of MPEP § 708.02 VIII(E). The present petition addresses only condition (E) under MPEP § 708.02 VIII. Conditions (A) through (D) were satisfied by the Petition to Make Special filed on June 11, 2003 and the Renewed Petition to Make Special filed on November 3, 2003 ("Renewed Petition").

MPEP § 708.02 VIII(E) - Detailed Discussion of References

The International Preliminary Examination Report ("IPER"), which issued on January 31, 2003 in corresponding PCT International Application No. PCT/US01/45483 ("PCT Application"), was submitted along with the Renewed Petition filed on November 3, 2003. The IPER explains that claims 1-26 of the PCT application are novel, demonstrate an inventive step, and have industrial applicability over the prior art. The IPER then elaborates on page 4 that the prior art does not teach or fairly suggest claims 1-26 of the PCT Application and then cites the claimed subject matter not present in the prior art. At the time of filing, the claims of the present application were identical to the claims of the PCT Application.

Despite the detailed discussion on page 4 of the IPER, the U.S.P.T.O. concluded that the IPER does not present a comprehensive and detailed discussion of "how the features of the claims of the present invention patentably define over each of the found references." Consequently, the U.S.P.T.O. decided that the Renewed Petition to Make Special filed on November 3, 2003 failed to adequately satisfy condition (E) under MPEP § 708.02 VIII.

While Applicants disagree that the IPER does not discuss "how the features of the

claims of the present invention patentably define over each of the found references," Applicants herewith submit the following comprehensive and detailed discussion of how the claimed subject matter is patentable over the found references.

The International Search Report dated August 28, 2002 ("Search Report"), which was attached to the Petition to Make Special filed on June 11, 2003, found seven references. A comprehensive and detailed discussion of how the claimed subject matter is patentable over these seven references follows.

The Claimed Subject Matter

The present application includes claims 15-16 and claims 27-39. Claims 1-14 and 17-26 were withdrawn in an Election filed on October 31, 2003. Of the pending claims, claim 15 is the only independent claim. Accordingly, claim 16 and 27-39 incorporate and further depend from the claimed subject matter of independent claim 15.

Claim 15 requires:

> A system for delivering targeted ads to a user operating a station connected to a distributed computer network, comprises:
>
> an ad server which maintains the targeted ads for the user at the station across the distributed computer network;
>
> a data store that identifies a set of rules associated with an ad, the rules indicate a level of relevancy of an ad to a particular content; and
>
> a match maker that parses the particular content by objects and corresponding attributes, that maps a targeted ad to the particular content by applying the rules in the data store, and that sends an identification of the targeted ad to the ad server.

According to the specification on page 33, lines 5-12:

The Match Maker system's administrator parses the content of the page that the Customer is viewing and identifies the objects and their attributes which are mentioned on the page. The Match Maker intelligently groups together the attributes belonging to a particular object. For example, assume that a page mentions several computers and mentions attributes for each computer, such as brand, processor type, and processor speed. The Match Maker will group together the attributes belonging to each computer object and produce a list of computer objects found on the page.

Detailed Discussion of the References

The claimed subject matter requires a matchmaker that parses a particular content by objects and corresponding attributes and then maps a targeted ad based upon this parsed content. Seven references were listed in the International Search Report dated August 28, 2003.

In short discussion, two of the seven references, namely International Publication Number WO 01/44992 A1 and U.S. Patent Publication No. 2002/0010625, are not prior art to the claimed subject matter. Accordingly, the claimed subject matter would be patentable over these two references regardless of their respective disclosures. Of the remaining five references, none disclose, teach, suggest, or render obvious parsing a particular content by objects and corresponding attributes, and then mapping a targeted ad based upon this parsed content. Accordingly, the claimed subject matter is patentable over the remaining five references for failure to disclose, teach, suggest, or render obvious a required limitation of the claimed subject matter.

A detailed discussion of the seven references follows.

1. W0/44992 A1 ("'992 publication")

The '992 publication discloses a system and method that contextually matches products and advertisements to the content of a user selected web page. The contextually matched products and advertisements are delivered to the user in real time.

The '992 publication has no bearing on the patentability of the claimed subject matter because the '992 publication is not prior art. The present invention has a priority date of October 31, 2000, while the '992 publication has an international filing date of October 31, 2000 and does not designate the U.S. Moreover, the international filing date is before November 29, 2000, so the old version of 35 U.S.C. §102(e) applies. (*See* MPEP §2136) Under the old version of 35 U.S.C. §102(e), a U.S. patent must issue. No such patent is of record with respect to the '992 publication However, the '992 application claims priority to a U.S. provisional application 60/170,974 filed on December 19, 1999. The filing of a U.S. provisional application also cannot make the '992 publication a reference. (*See* MPEP 2136.03 III)

Since, the international filing date of the '992 publication does not precede the priority date of the present invention, the disclosure found in the '992 publication cannot be used to prevent patentability of the claimed subject matter.

For at least the foregoing reasons, the claimed subject matter is patentable over the '992 publication.

2. US 2002/0010625 ("'625 application")

The '625 application discloses a system and method that matches products to a user

based upon the history of searches of that user over the Internet during the current browsing session.

Similar to the '992 publication, the '625 application is not prior art to the claimed subject matter. As discussed above, the present invention has a priority date of October 31, 2000, while the '625 application has a filing date of March 29, 2001. Since the filing date of the '625 application does not precede the priority date of the present invention, the disclosure found in the '625 application cannot be used to prevent patentability of the claimed subject matter.

The '625 application discloses a system and method that sends products based upon the activities of a community of users. Products are sent to the user based upon an analysis of user purchase histories, product viewing histories, and other types of historical browsing.

The '625 application does not disclose, teach, suggest or render obvious the delivery of targeted advertisements to a user connected to a distributed computer network based upon a particular content that has been parsed by objects and corresponding attributes. Rather, the '625 application delivers products based upon an analysis of user purchase histories, product viewing histories, and other types of historical browsing, and not based upon the content of the page being viewed. Because the '625 application does not disclose, teach, suggest, or render obvious a required limitation of the claimed subject matter, the '625 application cannot prevent the patentability of the claimed subject matter.

For at least the foregoing reasons, the claimed subject matter is patentable over the '625 application.

3. U.S. Patent No. 5,948,061 ("'061 patent")

The '061 patent discloses a system and method that sends targeted advertisements based upon profiles of networks and profiles of users on those networks. A user accesses a web page affiliated with an advertising server process. Through the use of the Internet address of the user and other information passed by the user's browser to the advertising server process, the advertising server process selects targeted advertisements based upon network profiles and user profiles on such networks.

The '061 patent does not disclose, teach, suggest or render obvious the delivery of targeted advertisements to a user connected to a distributed computer network based upon a particular content that has been parsed by objects and corresponding attributes. Rather, the '061 patent delivers targeted advertisements based upon the Internet address of the user, other information that has been passed to an advertising server process by the user's browser, and user and network profiles. Because the '061 patent does not disclose, teach, suggest, or render obvious a required limitation of the claimed subject matter, the '061 patent cannot prevent the patentability of the claimed subject matter.

For at least the foregoing reasons, the claimed subject matter is patentable over the '061 patent.

4. U.S. Patent No. 6,256,633 ("'633 patent")

The '633 patent discloses a system and method that identifies a document of potential interest to a user in an electronic database based upon previous user queries to the electronic database and the user's access history with the electronic database.

Similar to the '061 patent, the '633 patent does not disclose, teach, suggest or render obvious the delivery of targeted advertisements to a user connected to a distributed computer network based upon a particular content that has been parsed by objects and corresponding attributes. Moreover, the '633 patent relates to a nonanalygous art. More specifically, the '633 patent relates to the retrieval of documents, while the claimed subject matter relates to the delivery of targeted advertisements across a distributed computer network. Because the '633 patent does not disclose, teach, suggest, or render obvious a required limitation of the claimed subject matter, and further because the '633 patent relates to a nonanalygous art, the '633 patent cannot prevent the patentability of the claimed subject matter.

For at least the foregoing reasons, the claimed subject matter is patentable over the '633 patent.

5. U.S. Patent No. 6,308,202 ("'202 patent")

The '202 patent discloses a system and method for the distribution of targeted information to a user on a computer network based upon a pre-determined categorization of sites on the computer network. Each browsed web site is then mapped by the category of its address to services targeted to that category. The system then distributes that targeted information to the user.

Similar to the previously discussed references, the '202 patent does not disclose, teach, suggest or render obvious the delivery of targeted advertisements to a user connected to a distributed computer network based upon a particular content that has been parsed by objects and corresponding attributes in real time. Instead, the '202 patent discloses the distribution of

information to a user connected to a computer network based upon a pre-determined grouping of web pages according to categories of their content. As such that invention cannot work in real time on pages that were not pre-categorized, and cannot target in as detailed a fashion to specific keywords, objects, and attributes as can be done by the automated method disclosed in the present invention. Because the '202 patent does not disclose, teach, suggest, or render obvious a required limitation of the claimed subject matter, the '202 patent cannot prevent the patentability of the claimed subject matter.

For at least the foregoing reasons, the claimed subject matter is patentable over the '202 patent.

6. U.S. Patent No. 6,356,899 ("'899 patent")

Similar to the '202 patent, the '899 patent discloses a system and method for the distribution of targeted information to a user on a computer network based upon a predefined categorization of information. A user defines an informational database. The system then organizes web pages based upon the organizational structure that the user previously created.

Similar to the previously discussed references, the '899 patent does not disclose, teach, suggest or render obvious the delivery of targeted advertisements to a user connected to a distributed computer network based upon a particular content that has been parsed by objects and corresponding attributes by an entity other than the user. Instead, the '899 patent delivers information based upon the organizational structure that the user previously created. Moreover, the '899 patent relates to a nonanalygous art. More specifically, the '899 patent relates to the organization of web pages, while the claimed subject matter relates to the

delivery of targeted advertisements across a distributed computer network. Because the '899 patent does not disclose, teach, suggest, or render obvious a required limitation of the claimed subject matter, and further because the '899 relates to a nonanalygous art, the '899 patent cannot prevent the patentability of the claimed subject matter.

For at least the foregoing reasons, the claimed subject matter is patentable over the '899 patent.

7. U.S. Patent No. 6,366,298 ("'298 patent")

The '298 patent discloses a system and method that monitors the on-line activities of the user. Targeted advertisements could then be provided to the user based upon the monitored on-line activities.

The '298 patent does not disclose, teach, suggest or render obvious the delivery of targeted advertisements to a user connected to a distributed computer network based upon a particular content that has been parsed by objects and corresponding attributes. Instead, the '298 patent gathers information based upon monitored on-line activities of the user as derived by a sequence of resource locator strings correlated to that user. This is substantially different from the present invention which parses the content of the page being viewed and requires neither a stream of such information nor correlation to a specific user in order to deliver the targeted ad. Because the '298 patent does not disclose, teach, suggest, or render obvious a required limitation of the claimed subject matter, the '298 patent cannot prevent the patentability of the claimed subject matter.

For at least the foregoing reasons, the claimed subject matter is patentable over the '298

patent.

Conclusion

This Second Renewed Petition to Make Special in conjunction with both the Petition to Make Special filed on June 11, 2003 and the Renewed Petition to Make Special filed on November 3, 2003 satisfy the five requirements of MPEP §708.02 VIII and accordingly, the present Renewed Petition to Make Special should be granted.

Therefore, the present application should be advanced out of turn for examination. Applicants respectfully request such accelerated advancement.

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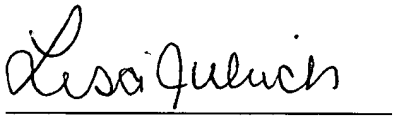
04-0100

Dated: January 8, 2004

Respectfully submitted,



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